THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM C. SETZER, RICHARD J. MALLLIRIS,
GARY W. BOONE, FRANK P. KOCH and DAVID K. YOUNG

Appeal No. 1996-3587
Application 08/401,043

ON BRIEF

Before JOHN D. SMITH, WARREN and KRATZ, *Administrative Patent Judges.*

WARREN, *Administrative Patent Judge.*

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 1, 31 through 46, 49, 51 through 60 and 70 through 72 as amended subsequent to the final rejection.[1]

We have carefully considered the record before us, and based thereon, find that we cannot sustain the sole ground of rejection of the appealed claims advanced on appeal under 35 U.S.C. §

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[1] Amendment of December 6, 1995 (Paper No. 10).

112, second paragraph. As pointed out by appellants in their brief, the claimed invention encompassed by the appealed claims is a master alloy hardener composition that is used to prepare an aluminum cast or ingot alloy or wrought aluminum alloy, as in the method of claim 70. According to appellants, the master alloy hardener compositions of the appealed claims contain 2 or more alloying elements consisting essentially of those specified which alloying elements are present at concentrations that are a multiple equal to or greater than 2 to 50 of the concentration of said alloying elements, but in the same ratios, as in the base alloy. See, e.g., claims 1, 31 and 70, and pages 2-8 of the brief. Indeed, we find that appellants' interpretation of the appealed claims reflects the disclosure in their specification, in which we note that it is admitted that it was known in the art that "[m]aster alloys provide the desired alloying elements in more concentrated form than the concentration of such elements in the final aluminum base product" (page 1) and appellants teach that the claimed "[m]aster alloys are added to commercially pure aluminum, scrap base alloy, or a combination thereof to produce the desired new base alloy" (page 6).

The initial burden of establishing a *prima facie* case on any ground under the second paragraph of § 112 rests with the Examiner. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992*), citing In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) ("As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability."). In making out a *prima facie* case of non-compliance with this statutory provision because the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as the invention, the examiner must establish that when the language of the appealed claims is considered as a whole as well as in view of the specification as it would be interpreted by one of ordinary skill in the art, the claims in fact fail to set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). In other words, the operative standard for determining whether § 112, second paragraph, has been complied with is "whether those skilled in the art would understand what is claimed when the claim is read in light of the specification." *See The Beachcombers, Int'l. v. WildeWood Creative Prods.*, 31 F.3d 1154,

1158, 31 USPQ2d 1653, 1656 (Fed. Cir. 1994), *quoting Orthokinetics Inc v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).

The examiner, in stating the rejection,[2] has set forth only conclusions without supporting reasons why those skilled in the art would *not* understand what is claimed when the claims are read in light of the specification. Accordingly, in the absence of a *prima facie* case, we reverse the rejection.

[2] While the examiner states that the ground of rejection is set forth in "paper number 8" (answer, page 2), which is the final rejection mailed September 28, 1995, the same is found instead on page 3 of the Office action of June 7, 1995 (Paper No. 5) as stated in Paper No. 8 (page 2). We have not considered the last two sentences on page 3 of Paper No. 5, which concern "a series" and "a specie," as applicable to the appealed claims because such terms do not appear in these claims. With respect to such subject matter, see appellants' specification, e.g., page 5.

The examiner's decision is reversed.

Reversed

JOHN D. SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
CHARLES F. WARREN	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
PETER F. KRATZ	)	
Administrative Patent Judge	)	

Bachman & Lapointe, P.C.
900 Chapel Street
Suite 1201
New Haven, CT 06510-2802